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09/541,197	04/03/2000	Jerome S. Golden	MML-003	4910
70813	7590	05/26/2009	EXAMINER	
GOODWIN PROCTER LLP			CHENCINSKI, SIEGFRIED E	
901 NEW YORK AVENUE, N.W.				
WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: JEROME S. GOLDEN

Application No. 09/541,197
Technology Center 3600

Mailed: May 22, 2009

Before KRISTA ZELE *Deputy Chief Appeals Administrator*
ZELE, *Deputy Chief Appeals Administrator.*

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on April 13, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

EXAMINER'S ANSWER, STATUS OF CLAIMS

A review of the file finds that the status of the claims as provided in the Examiner's Answer mailed December 31, 2008, under the heading "Status of Claims" is unclear and/or is not consistent with the status of claims of record in accordance with 37 CFR 41.37(c)(1)(iii). The status of the claims as provided in both the Examiner's Answer and the Appeal Brief must be consistent with the last entered amendment. Each claim on appeal must be identified. *See also Manual of Patent Examining Procedure (MPEP) § 1205.02 (8th ed. Rev. 6, Sept 2007)* for details.

A review of the last entered amendment finds that claims 55-93 are Rejected; whereas the examiner has not indicated the status of claims 70-74, 76-77, 90, and 92-93 or listed them as being rejected under 35 U.S.C. 103(a). Correction of the status of all claims is required.

EXAMINER'S ANSWER, GROUNDS OF REJECTION

A review of the file finds that the grounds of rejection of the claims as provided in the Examiner's Answer mailed December 31, 2008, under the heading "Grounds of rejection" is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection of the claims as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading "New Grounds of Rejection" in the Examiner's Answer and must include the approval of the TC Director or his/her designee. *See also Manual of Patent Examining*

Procedure (MPEP) § 1207.02 and 1207.03 (8th ed. Rev. 6, Sept 2007) for details.

A review of the Examiner's Answer finds a new Ground(s) of Rejection which does not include the approval of the TC Director or his/her designee.

Specifically, the Examiner's Answer sets forth a rejection of claims 80-93 as being rejected under 35U.S.C. 101; whereas the last Office action, including any mailed Advisory Action(s) does not include this rejection. Correction of all Grounds of rejection for all claims is required.

EXAMINER'S ANSWER, EVIDENCE RELIED UPON

Section §1207.02 of the *Manual of Patent Examining Procedure* (MPEP) (Eighth Edition, Rev. 6, September 2007) states:

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

....

(8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and in the case of nonpatent references, the relevant page or pages.

The Examiner's Answer mailed December 31, 2008, is deficient because the "Evidence Relied Upon" section fails to include the reference **TYLER** cited on page 10 in the Examiner's Answer's grounds of rejection of 56 and 81 under 35 USC § 103(a).

Appropriate correction is required.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) to vacate the Examiner's Answer mailed December 31, 2008;
- 2) to generate a new Examiner's Answer setting forth the correct status of claims and to correct other sections of the Answer as may be required;
- 3) and to include the approval of the TC Director or his/her designee (as required for any new grounds of rejection);
- 4) to issue a PTO-90 citing the missing references listed under the Evidence Relied Upon section, paragraph (8); and
- 5) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

KZ/alw

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